

PATENTS
930016-2002**REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1, 2 and 4-18 are now pending in this application. Claim 1 has been amended to include the claim language of claim 3 (which has been cancelled); similar language has also been inserted into claim 18. Claims 4, 8 and 9 have been amended to update the claim dependencies. No new matter has been added.

The applicants' position is essentially unchanged from the positions presented in the Appeal Brief and subsequent Reply Brief and for the Examiner's convenience, the arguments presented in the Appeal Brief are provided for here. However, the applicants respectfully request reconsideration of the previous rejection in light of the amendment to claim 1 and additional arguments presented here.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 112, 2nd PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 4-17 were rejected as allegedly being vague and indefinite for failing to describe the scope of the claimed invention. The applicants respectfully request reconsideration of this rejection.

Arguments from Appeal Brief filed on November 14, 2003

Appellants disagree with the Examiner's allegations that claims 5-7, 16 and 17; and claims 10-12, 14 and 15 are indefinite. A claim is definite if the scope of the subject matter embraced by a claim is clear and if the applicant has not otherwise indicated that he intends the claims to be of a different scope. *In re Borkowski*, 164 U.S.P.Q. 642 (C.C.P.A. 1970). The "distinctly claim" requirement of 35 USC § 112, second paragraph, means that the claims must have a clear and definite meaning when construed in light of the complete patent document.

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Standard Oil Co. v. American Cyanamid Co., 227 U.S.P.Q. 293 (Fed. Cir. 1985). The test of definiteness is whether one skilled in the art would understand the scope of the claim when read in light of the specification. *Morton Int. Inc. v. Cardinal Chem. Co.*, 28 U.S.P.Q.2d 1190 (Fed. Cir. 1993). And the degree of precision necessary is a function of the subject matter claimed. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 94-95 (Fed. Cir. 1986). Indeed, the Federal Circuit noted in *Hybritech* that:

‘[I]f the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more’ [and] the claims are clearly definite.

Id. at 94 (citing to *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 225 U.S.P.Q. 634, 641 (Fed. Cir. 1985)) (emphasis added).

Against this background, the claims are definite. Claims 5-7, 16 and 17 contain positive recitations of additional embodiments of the instant invention. For example, claim 5 defines a control means further comprising means for activating control lines; claim 6 defines a control means further comprising switch means; claim 7 further defines the means for moving to be responsive to the power lines; claim 16 provides for an apparatus that further comprises means for moving height adjusters; and claim 17 provides for an apparatus that further comprises means for controlling auxiliary gymnasium equipment.

Further, claims 10-12, 14 and 15 are not simply narrative. The claims may be read as providing a means for, *inter alia*, reducing cost, reducing complexity, increasing safety and consolidating electrical lines.

As the instant claims, read in light of the specification, apprise a skilled artisan of both the utilization and scope of the invention, and as the language is as precise as the subject matter permits, the instant claims are definite. A contrary conclusion, as posited by the Office Action, would not only be against public policy, but would also be impermissible as a matter of law. *See Hybritech*, 231 U.S.P.Q. at 95 (“As a matter of law, no court can demand more.”).

Consequently, the Board is asked to allow the rejected claims.

Additional arguments

It is further noted that the applicants are to be afforded a great deal of deference in defining their invention. MPEP 2173.02 states in part:

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"The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, *not whether more suitable language or modes of expression are available*. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. *Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.*" (emphasis added)

MPEP 707.07(g) states in part "[c]ertain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition."

Should the rejection under 35 U.S.C. 112, 2nd paragraph rejection, then the applicants request that the Examiner provide suggested claim language or an "improved mode of definition".

III. THE 35 U.S.C. 103 REJECTION HAS BEEN OVERCOME

Claims 1-18 (prior to amendment) had been rejected as being obvious over Berman (U.S. Patent 4,014,521) in view of Kesling (U.S. Patent 3,983,553) and "matters considered old and well known". The applicants respectfully request reconsideration of this rejection.

Arguments from Appeal Brief filed on November 14, 2003

Appellants disagree with the Examiner's characterization of the instant invention as being directed to simply "game courts, game equipment and areas having multiple game courts and game equipment use therein" (Final Office Action, at 2); or that the invention is mere automation. The Examiner has failed to appreciate the depth of Appellants' invention. More specifically, the instant invention provides for a sports enclosure apparatus defining an interior chamber. The chamber, in turn, is divided into a multiplicity of play arenas, wherein each arena has, for example, relays and a central control means. The relays control the means for moving at a first voltage, and the relays are responsive to relay control signals at a second voltage, wherein

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the second voltage being lower than said first voltage. The central control means separately operates each means for moving and generates the relay control signals.

The instantly claimed invention also provides for, *inter alia*:

- a numeric or alphanumeric keypad adapted to be programmed to require a security code for use;
- a central control means in the form of a touch screen which may be, for example, customized to depict virtual animation; and
- means for controlling auxiliary gymnasium equipment.

The instant invention also exhibits unexpected results and superiority over the art and, thus, rebuts any holding of *prima facie* obviousness. More specifically, the instant invention is operated with reduced cost, reduced complexity, increased safety, reduced insulation requirements, and with a consolidation of electrical lines. Indeed, one of the superior benefits of the instant invention is the cost savings that result from running low voltage control lines down to the control device, such as a key pad.

Appellants take exception to the Examiner's *nothing-is-patentable-because-everything-is-known* spin on obviousness as a basis for rendering Appellants' invention unpatentable. This is impermissible and unjustified. According to the Board of Patent Appeals and Interferences in *Ex parte Obukowicz*, 27 U.S.P.Q. 2d 1063, 1065 (B.P.A.I. 1992) (with emphasis):

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art *would lead* that individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Indeed, the teachings of references can be combined *only* if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 723 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

Indeed, it is well established that "there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Uniroyal v. Rudkin-Wiley*, 5 USPQ 2d 1434, 1438 (Fed. Cir. 1980).

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Further, as stated by the Court in *In re Fritch*, 23 USPQ 2d 1788, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification."

Against this background, the rejection of claims 1-18 as being unpatentable over Berman and Kesling is meritless. The Examiner has not established a *prima facie* case by failing to provide the necessary teaching, suggestion, incentive or motivation for modifying the cited art in order to arrive at the instant invention.

Berman simply relates to and claims divider nets for use between tennis courts. The divider nets have replaceable panels so that when a tennis player collides into the net, the damaged panel can be removed and replaced, thereby increasing the useful life of the net. Nowhere, however, is there any disclosure, teaching, suggestion or motivational recitation that would lead a skilled artisan to practice Appellants' invention. In other words, Berman is devoid of any teaching of a sports enclosure defining an interior chamber, said chamber being divided into a multiplicity of play arenas, said arena having, *inter alia*, a means for moving a basketball goal operating at a first voltage, relays for controlling said means, said relays being responsive to relay control signals at a second voltage, said second voltage being lower than said first voltage; and central control means for separately operating each means for moving, and generating said relay control signals.

Berman also fails to teach or suggest a numeric or alphanumeric keypad adapted to be programmed with a security code; a central control means in the form of a touch screen which may be, for example, customized to depict virtual animation; and means for controlling auxiliary gymnasium equipment.

Kesling does not remedy the inherent deficiencies in Berman. Kesling simply relates to a sound-emitting touch-pad for a domestic electrical appliance (like as a dishwasher). Contrary to the allegations in the Office Action, however, nowhere in Kesling is there any teaching, suggestion or motivational recitation that would lead a skilled artisan to practice the instantly claimed invention. Neither is there any suggestion or motivational recitation in Kesling that would lead a skilled artisan to combine its teachings with that of Berman, or vice versa. The only teaching, suggestion or motivation that would lead a skilled artisan to practice Appellants

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invention is found in the instant specification, and that is not the standard by which to base an obviousness rejection.¹

Indeed, following the Examiner's reasoning, the combination of Berman and Kesling would lead a skilled artisan to practice a tennis court net with a dishwasher's touch screen attached thereon. Appellants' invention is clearly patentably distinguishable from such a combination.

Appellants continue to believe that the Examiner erred by relying on *In re Venner* for the draconian allegation that automating a manual activity has been held to be obvious and not considered a patentable advance. The Federal Circuit was very clear that "reliance on per se rules of obviousness is legally incorrect and must cease." *In re Ochai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

Contrary to the Examiner's allegations, *Ex parte Brouillet* 2001 WL 1339914 (B.P.A.I. April 12, 2001) is on point and distinguishes *Venner* from the instant case. In *Venner*, all the limitations of the claims were disclosed in the applied references. Like *Brouillet*, that is not so here, as there is no suggestion in any of the cited documents for, *inter alia*, a means for moving a basketball goal operating at a first voltage, relays for controlling said means, said relays being responsive to relay control signals at a second voltage, said second voltage being lower than said first voltage; and central control means for separately operating each means for moving, and generating said relay control signals. Further, the Examiner has not established that manually adjusting the basketball goals accomplishes the same result as automatic adjustment utilizing a central control means. Manual adjustment, for example, does not prevent unauthorized adjustments. By contrast, the instantly claimed invention utilizes a keypad which is adapted to receive a security code in order to maintain security. Thus, according to the Board in the analogous *Brouillet* case, the Examiner "has not carried the burden of establishing a *prima facie* case of obviousness." *Brouillet*, 2001 WL 1339914 at *3.

Further, it is error for the Examiner to merely assert that a claimed element, not found in the cited art, is "well known in the art" if no reasons or authorities are relied upon for support. See *In re Pardo and Landau*, 214 U.S.P.Q. 673 (C.C.P.A. 1982); see also *In re Ahlert*, 165

¹ Appellants appreciate the Examiner's Phillips head screw/flathead screw analogy on page 3 of the Final Office Action. The Examiner, however, is comparing apples to apples, as these are both examples of screws. The cited art and the instant invention are, by contrast, far more disparate. Suffice it to say that a child's tricycle does not render a luxury automobile unpatentable, regardless of what is "well-known" in the art.

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U.S.P.Q. 418, 420-21 (C.C.P.A. 1970). In view of *In re Pardo and Landau* and *In re Ahlert*, it is improper for the Examiner to fail to cite a reference which specifically describes the instantly claimed sports enclosure having, *inter alia*, a defined playing zone, a basketball goal, means for moving the basketball goal, relays for controlling the means for moving the basketball goal, and central control means.

It is well-settled that "obvious to try" is not the standard upon which an obviousness rejection should be based. See *In re Fine*. And as "obvious to try" would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law. Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

Accordingly, for at least the reasons described above, the documents cited by the Examiner fail to render claims 1-18 unpatentable under 35 U.S.C. §103(a). Therefore, the rejected claims should be allowed.

Additional arguments

1. Preliminary notes about taking Official Notice of "common knowledge"

The rejections in the first Office Action and the final rejection relied on "matters considered old and well known". While the Examiner is permitted to take Official Notice, "these circumstances *should be rare* when an application is under final rejection... the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." MPEP 2144.03, section A (emphasis added)

Further, "[o]rdinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection)". MPEP 2144.03, section B.

Lastly, even if proper Official Notice is made, the applicants can traverse the holding of "common knowledge" and request that the Examiner support his contention of "common knowledge". Here, the applicants contest the holding of common knowledge as there is no evidence that the generic speculation that any process can be automated is applicable to the

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realm of sports arenas and basketball goals (e.g. a rationale presented by the Examiner was "greater profits for the sports arena" which has no basis in fact and could be argued that a manual operation would be cheaper and more profitable than an automated process).

It appeared that the Examiner's Answer tried to provide this additional evidence, however, the alleged "admitted prior art" found in specification on page 1, line 11 through page 2, line 10 is excluded by inserting the limitation of claim 3 into claim 1. In addition, the website references provided by the Examiner were all obtained on February 9, 2004 and while it can probably be assumed that these website posting were made at an earlier date, there is no evidence that these website references represented the state of the art *at the time the invention was made*, i.e. at least as of June 15, 2001 (date the CIP was filed) and possibly as far back as October 6, 1999 (date the original application was filed).

2. Supporting evidence of unexpected results

As noted above, the present claims excludes a central control means which is a key switch which had been the state of the art prior to the applicants invention to control multiple basketball goals. However, by comparing Exhibits A and B (attached to this response), one can see that the use of a keypad (labeled as "MEC Pad" in Exhibit A) can greatly reduce the amount of wiring necessary to control the basketball goals in the arena; can reduce the number of units required as part of the breaker panel; and can use lesser amounts of power to control the basketball goals (i.e. the voltage from the "MEC Pad" to the relay box is lower than that from the relay box to the basketball goals unlike the key switch devices which are representative of the prior art.

3. Evidence of commercial success

One of the four factual inquiries cited in *Graham v. John Deere* for the consideration and determination of obviousness includes evaluating evidence of secondary considerations. One of these considerations is supporting evidence of unexpected results (which is discussed in paragraph 2 above). Another consideration is commercial success, long felt need and copying by others. The applicants expect to provide a declaration for the Examiner's review which shows one or more of these considerations.

With respect to commercial success, the U.S. Supreme Court in *Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co.*, 321 U.S. 275 (1944) stated "[v]iewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the

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field, but this is not enough to negative invention...Once the method was discovered it commended itself to the public as evidence of commercial success. These factors were entitled to weight in determining whether the improvement amounted to invention and should, in a close case, tip the scales in favor of patentability."

While the applicants have believed that providing this evidence of commercial success was not necessary to show that the claimed invention was unobvious over the references cited by the Examiner, providing evidence of commercial success greatly increases the burden on the Examiner to maintain a holding of obviousness as the rejection must be greater than a "close case" in favor of obviousness.

REQUEST FOR INTERVIEW

In the interest of adhering to the tenets of compact prosecution and obtaining good customer service (see page 7 of the FY-2004 Performance and Accountability Report), the applicants request that the teachings of MPEP 707.07(j), sections II and III be applied, especially with regard to the offer of suggestion for correction by the Examiner if the rejections are upheld. In accordance with MPEP 713.01, section III, should any issue remain as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested; and, the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview ("An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present in the office." *Id.*).

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320. Favorable action is earnestly solicited.

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Respectfully submitted,

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Attorneys for Applicants

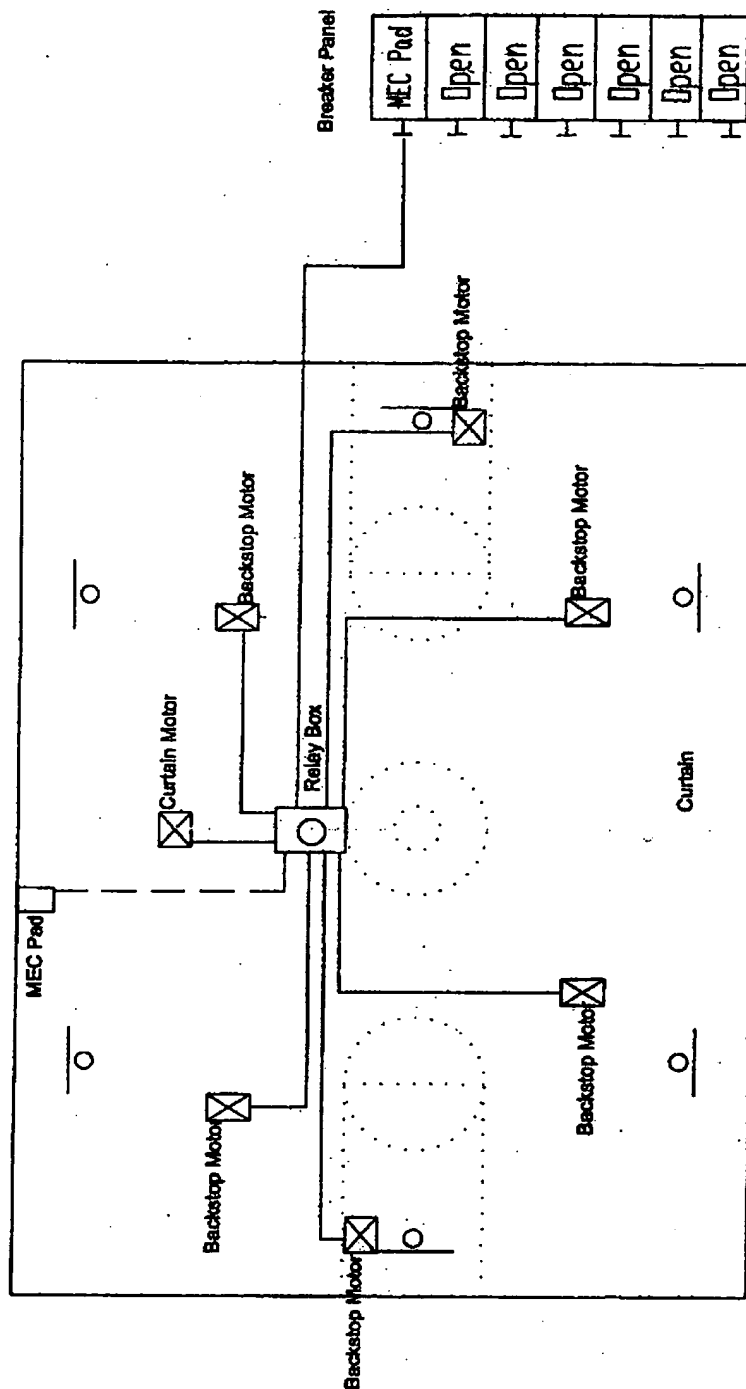
By: Howard C. Lee
Ronald Santucci
Reg. No. 28,988

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Attachment: Exhibit A - MEC Pad Comparison - MEC Pad Electrical Layout
Exhibit B - MEC Pad Comparison - Key Switch Electrical Layout

EXHIBIT A

MEC PAD COMPARISON - MEC PAD ELECTRICAL LAYOUT



KEY

☒ MOTOR
☐ KEY SWITCH
☐ RELAY BOX

115V/16A . POWER LINE
 12 / 2-WIRE FROM BREAKER TO RELAY BOX
 12 / 3-WIRE FROM RELAY BOX TO MOTORS
 12VDC 4-WIRE 22 GAUGE, FROM KEY PAD
 TO RELAY BOX.

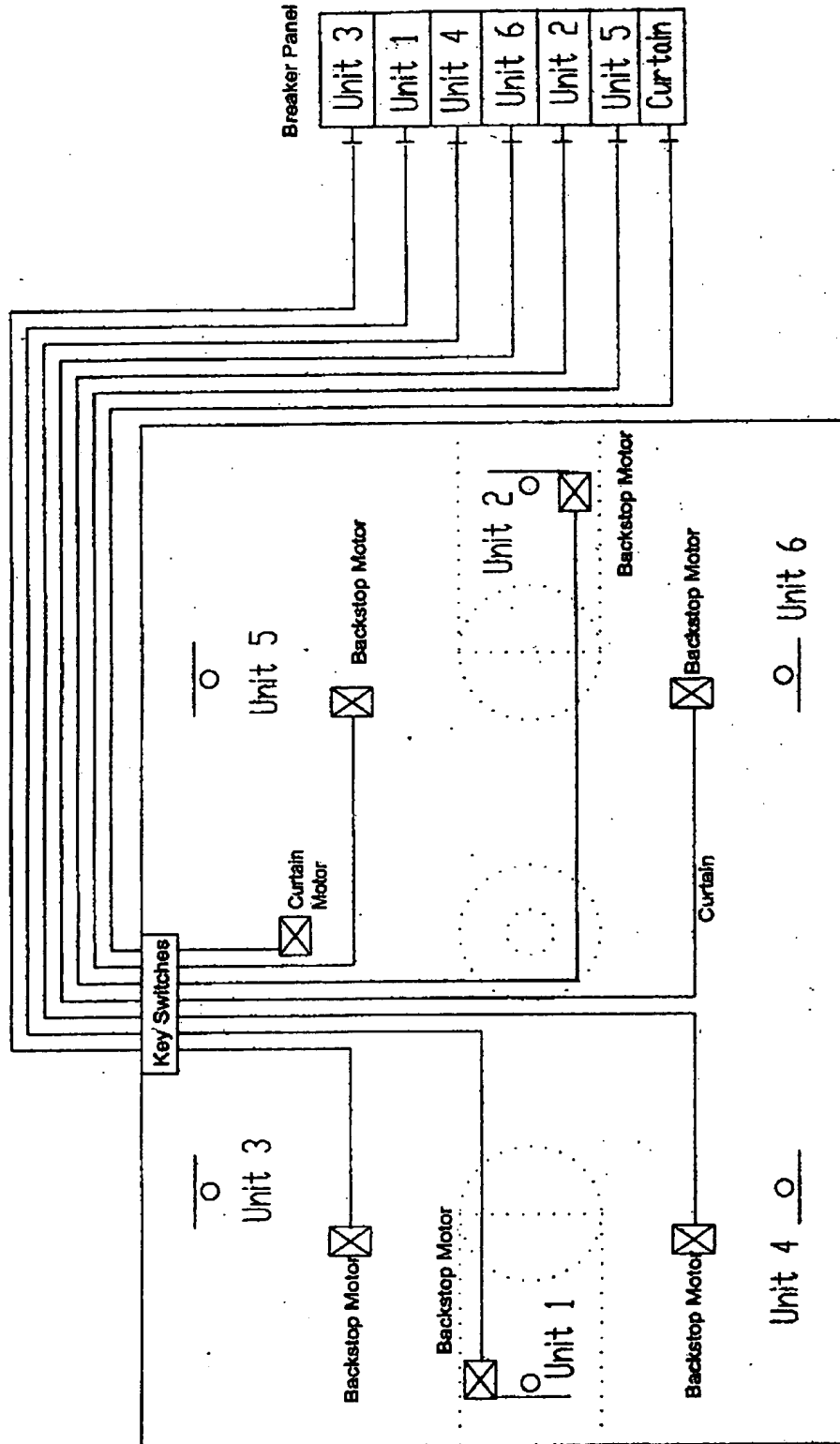
NOTES:

Gym Size = 80' X 110' X 30' high

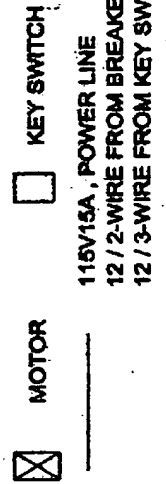
Breaker Panel located 30' from Gym - centered on end of Gym

EXHIBIT B

MEC PAD COMPARISON - KEY SWITCH ELECTRICAL LAYOUT



KEY



NOTES:

Gym Size = 80' X 110' X 30' high

Breaker Panel located 30' from Gym - centered on end of Gym